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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,272	10/05/2005	James Michael Mattern	26978A-002710US	2138
77196	7590	09/17/2008		
Townsend and Townsend and Crew LLP Two Embarcadero Center San Francisco, CA 94111-3834			EXAMINER KOYAMA, KUMIKO C	
			ART UNIT	PAPER NUMBER
			2887	
			MAIL DATE	DELIVERY MODE
			09/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,272	<b>Applicant(s)</b> MATTERN, JAMES MICHAEL	
	<b>Examiner</b> KUMIKO C. KOYAMA	<b>Art Unit</b> 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 15-25, 27, 29, 30, 32-42, 44, 47-61, 63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 15-25, 27, 29, 30, 32-42, 44, 47-61, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Amendment received on June 20, 2008 has been acknowledged.

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-9, 12, 15-25, 27, 29, 30, 32-35, 37-42, 44, 47-61, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelmann et al (US 4,757,537) in view of Herbert (US Patent Application Publication No. 2002/0087493 A1).

Edelmann discloses a microcomputer 16 that receives a validation number and meter number from the document 15, box 46 by keyboard, bar code reader or the like. That validation number would be decrypted and postal information would be generated, box 47 in human

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readable form (col 5, lines 60-66). That information will be compared to the postal information on the document and in the post office files. If there a match between the information on the document and the information displayed, then the post office knows that there is a valid postage imprint. If there is not a match, then the post office knows that the imprint is invalid (col 6, lines 4-10).

Edelmann fails to teach assigning the mail item as being spoiled mail item, separating the spoiled mail item from the mail item stream, presenting at least one of the spoiled mail item and the associated postage imprint to a postage service so that the sensitive information is not readable by the postage service, and refunding the value applied to the spoiled mail item based on a determination by the postage service.

Herbert discloses a mail item may become spoiled or damaged after a postage charge for the mail item has been accounted for by the postage meter, for example, the mail item may be damaged during or after the printing of the postage imprint. Also a sender of mail may decide not to dispatch a specific mail item that has been processed by the postage meter. In these instances accounting for postage charge in respect of the spoiled or removed item has been effected and then it is necessary to go through a refund procedure with the postal authority in order to obtain a refund of the postage charge in respect of mail items which are not entered into the postal system (Paragraph [0002], lines 6-17).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Herbert to the teachings of Edelmann such that the customer is not charged for the postage that is not being used, and the customer can utilize the refunded credit towards the next mailing item.

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4. Claims 3 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelmann in view of Herbert as applied to claims 2 and 35 above, and further in view of Tajima (US 4,797,937). The teachings of Edelmann as modified by Herbert have been discussed above.

Edelmann as modified by Herbert fails to teach that the validation criterion requires the postage imprint to have at least one physical characteristics, comprising at least one of a position, size, and color of the postage imprint.

Tajima discloses a postage stamp identifying apparatus, in which color characteristic patterns of the stamp are extracted as feature vector from a stamp, and the detector color characteristic pattern of the stamp is compared with each of standard color characteristic patterns prepared beforehand for known stamp (col 1, lines 42-50).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Tajima to the teachings of Edelmann as modified by Herbert because different color postage are utilized to identify a certain type of mail, and therefore, color can be used to easily determine whether the correct postage is applied.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-9, 12, 15-25, 27, 29, 30, 32-42, 44, 47-61, 63 and 64 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUMIKO C. KOYAMA whose telephone number is (571)272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kumiko C. Koyama/  
Primary Examiner, Art Unit 2887  
September 15, 2008